Group I: Claims 1-2, drawn to the method for identifying genes;

Group II: Claims 3, drawn to the method of generating nucleic acid probes;

Group III: Claims 4, drawn to the method of providing kits for detecting the level of expression of genes;

Group IV: Claims 5-7, drawn to the method for determining the phenotype of a cell;

Group V: Claims 8-11, drawn to the kit for assessing a patient's risk of having or developing an inflammatory bowel disease;

Group VI: Claim 12, drawn to the method of doing a business for assessing a patient's risk of having or developing an inflammatory bowel disease;

Group VII : Claim 13, drawn to the method for treating a patient who has developed , or is at risk of developing, an inflammatory bowel disease;

Group VIII: Claims 14-15, drawn to the nucleic acid array;

Group IX: Claim 16, drawn to the drug screening assay;

Group X: Claim 17, drawn to the method for treating an animal having an inflammatory bowel disease; and

Group XI: Claim 18, drawn to the pharmaceutical preparation.

Applicants respectfully traverse.

Applicants assert that the claims of the present invention have been improperly restricted into separate inventions.

Specifically, Applicants assert that claims 1 to 4 have been improperly restricted into three separate inventions, that is as, Group I, claim 1; Group II, claim 3; and Group III, claim 4. Applicants respectfully submit that claims 1 to 4 are directed to the same invention, and therefore should be grouped as a single invention.

MPEP §806.5(a) defines the relationship between combination and sub-combination as follows,

A combination is an organization of which a subcombination or element is a part.

Applicants submit that claim 1 is, as such, a subcombination, and claims 2 to 4 are combinations that include the steps recited in claim 1. MPEP §806.5(c) states,

Where a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction; i.e., separate classification, status, or field of search. Emphasis added.

In the present case, Claims 2 to 4 are dependent to claim 1, therefore by definition, they set forth the details of the subcombination, that is, claim 1, as claimed. The relationship between claims 2 to 4 and claim 1 is such that the separately claimed sub-combination of elements in claim 1 constitutes the essential distinguishing feature of the combination of claims 2 to 4. Therefore the inventions are not distinct. The additional elements in the combination inventions aside from those of claim 1 are not separately patentable, and lastly, claims 1 to 4 belong to the same class 435. For these reasons, Applicants respectfully submit that the restriction to claims 1 to 4 to three inventions, is not proper. Applicants

respectfully submit that claims 1 to 4 should properly be grouped as a single invention.

In addition, Applicant assert that claims 13 and 17 have been improperly restricted into two inventions, that is as Group VII, claim 13, and Group X, claim 17.

Claim 13 is drawn to the method of treating a patient who has developed, or is at risk of developing, an inflammatory bowel disease, classified in class 536, subclass 23.1. Claim 17 is drawn to the method for treating an animal having an inflammatory bowel disease, classified in class 536, subclass 23.1. Claim 13 is directed to a patient, whereas claim 17 is directed to an animal, Applicant respectfully submit that "a patient" is a subset of "an animal." Therefore, claim 13 differs from claim 17 only in that claim 13 is directed to another aspect of the subject matter claimed in claim 17. Applicant also notes that claims 13 and 17 have been classified to the exact same class/subclass classification, therefore there is no undue burden caused by the search.

Applicant acknowledges that election of one of the inventions is required under 35 U.S.C. § 121. Applicants elect the claims set forth in Group IV, drawn to claims 5 to 7 for examination. Claims 1 to 4 and 8 to 18 are cancelled herein without prejudice to Applicant's pursuing prosecution of the subject matter of claims 1 to 4, and 8 to 18 in a related application claiming the benefit of priority of the subject application.

The Restriction Requirement specifies that, if the claims of Group IV are elected for examination, a single gene from Table 1 is to be selected as a species for prosecution. Applicants elect the gene "MMP-12 (Macrophage elastase)." This gene is taught in Table 1, page 55, as the first listing in group VII with Accession No. L23808. It is also taught at page 8, beginning at line 35; and as well as other places in the specification.

In summary, Applicants respectfully traverse the restriction requirement, specifically to the restriction of claims 1 to 4 as three separate inventions, and claims 13 and 17 as two separate inventions. As required, Applicants have elected the invention of Group IV, claims 5 to 7 for prosecution, with the further election of the gene "MMP-12" as the species selected for examination. The Examiner is invited to call Cathryn Campbell or the undersigned attorney if there are any questions.

Respectfully submitted,

May 13, 2002
Date

James J. Wong
Registration No. 34,949
Telephone No. (858) 535-9001
Facsimile No. (858) 535-8949

CAMPBELL & FLORES LLP
4370 La Jolla Village Drive
7th Floor
San Diego, California 92122
USPTO CUSTOMER NO. 23601